UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,322	11/27/2001	Michael L. Gough	NEO1P026.US02	3459

45965 7590 12/22/2008

TIPS GROUP
c/o Intellevate LLC
P. O. BOX 52050
Minneapolis, MN 52050

EXAMINER	
PHAM, KHANH B	

ART UNIT	PAPER NUMBER
2166	

MAIL DATE	DELIVERY MODE
12/22/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/997,322	GOUGH ET AL.	
	Examiner	Art Unit	
	Khanh B. Pham	2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 September 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,33-51,61-65 and 84-86* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,33-51,61-65 and 84-86* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: The "Related Application" section on page 1 must be amended to provide current status for the related applications.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 46-51, 61-65 are rejected under 35 U.S.C. 102(b)** as being anticipated by XP-002150023 ("Streaming Email"), hereinafter "**Streaming Email**".

As per claim 46, "Streaming Email" teaches an audiovisual e-mail system comprising:

- "means transmitting over a network to a server from a sender machine an audiovisual enhancement which is associated with a message from said sender", said message to be sent as an e-mail to at least one recipient on said network" at pages 310-312; and

- "means associating said message with a self-executing program operative to stream said audiovisual enhancement, at least in part, from said server over said network and to display said audiovisual enhancement in conjunction with said message on a recipient machine upon the selection of said message by said at least one recipient" at page 312-313.

As per claim 47, "Streaming Email" teaches an audiovisual e-mail system as recited in claim 46 wherein "said audiovisual enhancement includes both audio and visual components" at page 309.

As per claim 48, "Streaming Email" teaches an audiovisual e-mail system as recited in claim 46 wherein "said audiovisual enhancement includes only an audio component" at page 309.

As per claim 49, "Streaming Email" teaches an audiovisual e-mail system as recited in claim 46 wherein "said audiovisual enhancement includes only a visual component" at page 309.

As per claim 50, "Streaming Email" teaches the audiovisual e-mail system as recited in claim 46 wherein "said audiovisual enhancement includes a streaming video displayed within a window of said recipient's machine" at page 313.

As per claim 51, "Streaming Email" teaches the audiovisual e-mail system as recited in claim 46 wherein "said audiovisual enhancement is developed on said sender's machine" at page 310.

As per claim 61, "Streaming Email" teaches a method for providing active e-mail comprising:

- "generating a sender email" at page 309;
- "including a code segment in said email to cause a self-executing, transient code segment to automatically download over a network and execute within a context of said email upon an opening of said email " at page 309;
- "sending said e-mail to a recipient" at page 309.

As per claim 62, "Streaming Email" teaches "an email server comprising a computer configured to receive e-mail text from a sender, to associate said e-mail text with a code segment and to send said code segment to a recipient in a body of an email" at page 309.

As per claim 63, "Streaming Email" teaches a computer program embodied on a computer readable media for providing active email comprising: "software segment receiving email text from a sender ; software segments associating said email text with a code segment; and software segments sending said code segment to a recipient in a body of an email" at page 309.

As per claim 64, “Streaming Email” teaches a method for providing e-mail comprising: "providing a link between an open email on a recipient computer and a stored audio and/or video file not on said recipient computer; and streaming said audio and/or video file to said recipient computer for display within said open email in such a manner that other content of said email which is intended to be viewed is not visually obscured” at pages 313-314.

As per claim 65, “Streaming Email” teaches a computer program embodied on computer readable media for providing email comprising: “software segments providing a link between an open email on a recipient computer and a stored audio and/or video file not on said recipient computer; and software segments streaming said audio and/or video file to said recipient computer for display within said open email in such a manner that other content of said email which is intended to be viewed is not visually obscured” at pages 313-314.

4. **Claims 84-86** are rejected under 35 U.S.C. 102(e) as being anticipated by Cleron et al. (US 6,223,213 B1), hereinafter “**Cleron**”.

As per claim 84, Cleron teaches a method for enhancing an email comprising: “enhancing an email with an HTML code segment; and reviewing the enhancement of said email by executing said HTML code segment prior to sending said email” at Col. 6 line 63 to Col. 7 line 55 .

As per claim 85, “Streaming Email” teaches an email server comprising a computer configured to enhance an email with an HTML code segment and to permit the review the enhancement of said email by executing said HTML code segment prior to sending said email" at Col. 6 line 63 to Col. 7 line 55.

As per claim 86, “Streaming Email" teaches a computer program for enhancing email comprising: "software segments for enhancing an email with an HTML code segment; and software segments for reviewing the enhancement of said email by executing said HTML code segment prior to sending said email” at Col. 6 line 63 to Col. 7 line 55.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. **Claims 1, 33-45** are rejected under 35 U.S.C. 103(a) as being unpatentable over XP-002150023 (“Streaming Email”), hereinafter “**Streaming Email**” and in view of Tolba et al. (“Pure Java-based Streaming MPEG Player”), hereinafter “Tolba”.

As per claim 1, "Streaming Email" teaches a method for providing an audiovisual e-mail system (pages 308-315, Video Express Email) comprising:

- "providing a server connected to a network" at page 309;

("Streaming Email" teaches the ImageMind's Web Server connected to the Internet)

- "inputting a message and an audiovisual enhancement which is associated with said message from a sender into said server, said message to be sent as an e-mail to at least one recipient on said network" at page 309;

("Streaming Email" teaches the step of selecting video and audio data (i.e., "audiovisual enhancement")to a video e-mail message)

- "associating said message with a self-executing, network downloadable programmable enhancement operative to automatically stream said audiovisual enhancement, at least in part, from said server over said network upon the opening of said email and to display said audiovisual enhancement within said email in conjunction with said message " at pages 309, 313-314;

("Streaming Email" teaches that video player can be attached to the e-mail message and is used to stream video file with the email)

- "and sending said e-mail over said network to said at least one recipient" at page 9.

The different between “Streaming email" and the invention of claim 1 is that "Streaming email" does not explicitly teach "display said audiovisual enhancement within said email in conjunction with said message **without the requirement of a previously installed viewer**”. However, Tolba teaches a Java-based streaming MPEG-1 video player in which “t**he uses will no longer need to pre-install any software plug-ins to display video**” (See Abstract, page 216). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the Java-base streaming video player as taught by Tolba with "Steaming email" as suggested by Tolba. Tolba discussed at page 216 four advantages of using a Java-based player including "program written entirely in Java run across platforms… without the need for native libraries. This allows greater use of MPEG video sequence because the users will no longer need to pre-install any software plug-in to display video”, “Java’s small footprint and availability”, “Java programs are compact”, “extensive networking capabilities are built into the language, making it easy to write programs that use the Internet communication". All of these advantages will greatly improve “Streaming Email” system because it will reduce the time and resource to download and install the player and increase user's satisfaction with the system.

As per claim 33, “Streaming Email” and Tolba teach the method as recited in claim 1 discussed above. “Streaming Email” also teaches: wherein “said audiovisual enhancement includes both audio and visual components” at page 309.

As per claim 34, "Streaming Email" and Tolba teach the method as recited in claim 1 discussed above. "Streaming Email" also teach: wherein "said audiovisual enhancement includes only an audio component" at page 309.

As per claim 35, "Streaming Email" and Tolba teach the method as recited in claim 1 discussed above. "Streaming Email" also teaches: wherein "said audiovisual enhancement includes only a visual component" at page 309.

As per claim 36, "Streaming Email" and Tolba teach the method as recited in claim 1 discussed above. "Streaming Email" also teaches: wherein "said audiovisual enhancement includes a streaming video displayed within a window of a recipient's machine" at pages 312, 314.

As per claim 37, "Streaming Email" and Tolba teach the method as recited in claim 1 discussed above. "Streaming Email" also teaches: wherein "said audiovisual enhancement is developed on a sender's machine, and is transmitted to said server over said network" at page 310.

As per claim 38, "Streaming Email" and Tolba teach the method as recited in claim 37 discussed above. "Streaming Email" also teaches: wherein "said network includes a TCP/IP network" at page 311.

As per claim 39, "Streaming Email" and Tolba teach the method as recited in claim 38 discussed above. "Streaming Email" also teaches: wherein "said network includes the Internet" at page 308.

As per claim 40, "Streaming Email" teaches computer program segments embodied in computer readable media to provide an audiovisual e-mail system comprising:

- "a code segment transmitting over a network to a server an audiovisual enhancement which is associated with a message from a sender, said message to be sent as an e-mail to at least one recipient on said network" at page 309;
- "a code segment associating said message with a self-executing, network downloadable code segment operative to automatically stream said audiovisual enhancement, at least in part, from said server over said network and to display said audiovisual enhancement within said email in conjunction with said message upon the selection of said message by said at least one recipient" at pages 309-313.

The different between "Streaming email" and the invention of claim 1 is that "Streaming email" does not explicitly teach "display said audiovisual enhancement within said email in conjunction with said message **without the requirement of a previously installed viewer**". However, Tolba teaches a Java-based streaming MPEG-1 video player in which "t**he uses will no longer need to pre-install any software plug-ins to display video**" (See Abstract, page 216). Thus, it would have

been obvious to one of ordinary skill in the art at the time of the invention was made to combine the Java-base streaming video player as taught by Tolba with "Steaming email" as suggested by Tolba. Tolba discussed at page 216 four advantages of using a Java-based player including "program written entirely in Java run across platforms… without the need for native libraries. This allows greater use of MPEG video sequence because the users will no longer need to pre-install any software plug-in to display video", "Java's small footprint and availability for small devices", "Java programs are compact", "extensive networking capabilities are built into the language, making it easy to write programs that use the Internet communication". All of these advantages will greatly improve "Streaming Email" system because it will reduce the time and resource to download and install the player and increase user's satisfaction with the system.

As per claim 41, "Streaming Email" and Tolba teach the computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 discussed above "Streaming Email" also teaches: wherein "said audiovisual enhancement includes both audio and visual components" at page 309.

As per claim 42, "Streaming Email" and Tolba teach computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 discussed above. "Streaming Email" also teaches:

wherein “said audiovisual enhancement includes only an audio component” at page 309.

As per claim 43, “Streaming Email” and Tolba teach computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 discussed above. “Streaming Email” also teaches: wherein “said audiovisual enhancement includes only a visual component” at page 309.

As per claim 44, “Streaming Email” and Tolba teach computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 discussed above. “Streaming Email” also teaches: wherein “said audiovisual enhancement includes a streaming video displayed within a window of said recipient's machine” at page 312.

As per claim 45, “Streaming Email” and Tolba teach computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 discussed above. “Streaming Email” also teaches: wherein “said audiovisual enhancement is developed on a sender's machine” at page 310.

Response to Arguments

7. Applicant's arguments filed 9/22/2008 have been fully considered but they are not persuasive. The examiner respectfully traverses applicant's arguments.

The Cited Art.

In response to applicant's requesting the identification of the "Streaming Email" document, the examiner hereby send out a new 892 form with complete identification information of the cited "Streaming Email" reference.

Claims 1 and 33-45.

Applicant's arguments with respect to claims 1, 33-45 have been considered but are moot in view of the new ground(s) of rejection.

The newly cited Tolba reference teaches a Java-base streaming player which does not require user to pre-install any software to display the video, and in combination with "Streaming Video" render the claims obvious.

Claims 46-51

Regarding claim 46-51, applicant argued that "Streaming Email" does not teaches the use of a self-executing program to stream an audiovisual enhancement and to display it in conjunction with an email message". On the contrary, "Streaming Email" teaches at page 312 that "Most email program like Netscape Mail and Eudora allow you to double click on the message to launch it with its specified player. Double click on it and the Video Express Mail miniplayer should launch and play the message".

"Streaming Email" therefore teaches a self-executing miniplayer to stream and display video in conjunction with an email message as claimed.

Claim 61

Regarding claim 61, applicant argued that “Streaming Email” does not teach “generating a sender email including an instruction to cause a code segment to automatically download over a network and execute within a context of the email when it is opened by a recipient" On the contrary, “Streaming Email” teaches all clamed limitation as detailed in the rejection above.

Claims 62-63

Regarding claims 62-63, applicant argued that “Streaming Email” does not teach “receiving email text from a sender, associating the email text with a code segment, and sending the code segment to a recipient in a body of an email”. On the contrary, “Streaming Email” teaches all limitation as detailed in the rejection above.

Claims 64-65

Regarding claim 64-65, applicant argued that “Streaming Email” does not teach "streaming the audio and/or video file to the recipient computer for display within the open e-mail in such a manner that other content of the email which is intended to be viewed is not visually obscured. On the contrary, as shown in "Streaming Email" at Fig. 18.6, the video is displayed in a small window, comparing to the user interface for

displaying the email, and could be moved to an empty space on the user screen, therefore, **other content** of the email is not visually obscured.

Claims 84-86

Applicant's arguments with respect to claims 84-86 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh B. Pham whose telephone number is (571) 272-

4116. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Khanh B. Pham/
Primary Examiner
Art Unit 2166

December 19, 2008